

### **REMARKS**

Claims 1-2, 5, 7, 9, 17, 29-30, 48-58, and 60-64, as amended, and new claim 65 are pending in this application. In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

In particular, independent claims 1, 29-30, 61, and 63 have been rewritten to further clarify the embodiments of the present invention recited therein. In addition, various dependent claims have been rewritten or canceled to maintain consistency with the language now recited in the independent claims. Finally, new claim 65 has been added to recite an additional embodiment of the invention fully supported by the Written Description. *See, e.g.*, Page 12, lines 2-3. As no new matter has been added, Applicants respectfully request entry of these remarks at this time.

### **ALLOWABLE SUBJECT MATTER**

Applicants respectfully submit that claims 2 and 5, as pending prior to the April 3, 2007 Response, were previously indicated to be allowable by the Examiner. January 3, 2007 Office Action at Page 8. In response, new claims 61 and 63 were added to include the subject matter previously recited in claims 1 and 5 and claims 1 and 2, respectively. April 3, 2007 Response at Pages 6-8.

In the current Office Action, claims 61 and 63, and those claims depending therefrom, were rejected under 35 U.S.C. § 101. In addition, claim 63 was rejected under 35 U.S.C. § 102 based on Cuscurida. While Applicants respectfully disagree with the Examiner's rejection under 35 U.S.C. § 101, all of the independent claims have been amended in an attempt to overcome the § 101 rejection. As such, at a minimum, claims 61-62 appear to be in condition for allowance.

However, it is Applicants' position that claims 63-64 are also in condition for allowance despite the Examiner's § 102 rejection of claim 63. It is unclear to Applicants whether the § 102 rejection of claim 63 is unintentional or is a result of the Examiner withdrawing his previous indication of allowance. Office Action at Page 3. Regardless, for the sake of completeness, the § 102 rejection of claim 63 is addressed in more detail below.

### **THE REJECTION UNDER 35 U.S.C. § 101**

Claims 1-2, 5, 7, 9, 17, 29-30, 48-58, and 60-64 were rejected under 35 U.S.C. § 101 for the reasons set forth in the Office Action at Page 2. While Applicants disagree with the Examiner's characterization of the previously pending claims as not accomplishing a practical application or producing a useful, concrete, and tangible result, in the interest of expediting allowance, Applicants have amended the claims to further recite the steps of curing the reaction mixture to form a portion of a golf ball and removing the portion from the mold.

In light of the amendments herein, Applicants respectfully submit that the § 101 rejection is overcome. Reconsideration and withdrawal of the § 101 rejection is respectfully requested.

### **THE REJECTION UNDER 35 U.S.C. §§ 102 & 103**

Claims 1, 4, 17, 30, 55-57, and 63 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 4,301,110 to Cuscurida *et al.* for the reasons provided on pages 3-6 of the Office Action.<sup>1</sup> The Examiner also rejected claim 54 under § 103(a) as obvious over Cuscurida in view of U.S. Patent No. 4,288,586 to Bock *et al.* as stated on pages 5-6 of the Office Action. Finally, claims 29, 48-53, and 58-60 were rejected under § 103(a) as obvious over Cuscurida in view of U.S. Patent No. 6,174,984 to Peter as provided on pages 6-8 of the Office Action. None of these references disclose or suggest the presently recited invention for at least the reasons that follow.

Cuscurida generally discloses a method for making reaction injection molded (RIM) polyurethanes for use in automobile parts. Col. 1, lines 40-52. In particular, Cuscurida teaches a polyurethane elastomer made with a RIM process that involves an aromatic polyisocyanate, a high molecular weight polyol, and a chain extending agent. Col. 1, lines 55-66. Cuscurida is completely silent as to the use of these elastomers for golf equipment and, in particular, golf balls or portions thereof.

Furthermore, Cuscurida does not teach or suggest the use of a prepolymer or first reactable component that is a reaction product of an isocyanate and a polyamine or an epoxy. In contrast, the invention now recited features a first reactable component that is based on the

---

<sup>1</sup> Applicants respectfully submit that claim 4 was cancelled in the April 3, 2007 Response. As such, Applicants have not addressed the Examiner's rejection of this claim. In addition, the rejections based on Cuscurida alone appear under a heading entitled "Claim Rejections - 35 U.S.C. § 103, however, the actual rejection uses 35 U.S.C. § 102(e) as the basis for the rejection. For the sake of completeness, Applicants have

reaction product of an isocyanate and a polyamine, epoxy-containing compound, or a mixture thereof. In other words, the first reactable component of the present invention includes urea or epoxy linkages. Even assuming *arguendo*, that a skilled artisan would be motivated to use a prepolymer from the Cuscurida disclosure of a quasi-prepolymer in Example 3, this quasi-prepolymer is the reaction of 1 part by weight polyol and 1 part by weight aromatic isocyanate. Col. 6, lines 16-61. As such, any "prepolymer" produced as a result of Cuscurida would contain only urethane linkages, not urea or epoxy linkages, as presently recited. Thus, a skilled artisan would not have been motivated to arrive at the presently recited invention absent the use of impermissible hindsight.

With regard to the secondary references cited by the Examiner, the only motivation that a skilled artisan would have had to combine the references in the manner suggested by the Examiner exists through hindsight. Neither Bock nor Peter even suggest the use of polyurethane compositions or components thereof in forming golf balls. In fact, Bock is limited to a new process for preparing polyisocyanates and is completely silent as to the use of RIM for forming golf equipment. Col. 2, lines 48-54.

Peter is similarly silent as to a method for producing golf balls or portions thereof; rather, Peter is generally directed to polyurethane elastomers that are formed from a urethane prepolymer (a reaction product of an isocyanate and a high molecular weight hydroxy-terminated compound) and a chain extender. Col. 4, lines 27-37. As such, Bock and Peter do not remedy the deficiencies of the primary reference with respect to the presently recited invention.

For at least the reasons above, none of these references disclose or suggest the present invention. As such, Applicants respectfully request that the § 103 rejections be reconsidered and withdrawn.

### **CONCLUSION**

All claims are believed to be in condition for allowance. If the Examiner believes that the present amendments still do not resolve all of the issues regarding patentability of the pending claims, Applicants invite the Examiner to contact the undersigned attorneys to discuss any remaining issues.

A Request for Continued Examination is submitted with provision for the requisite fee. No other fees are believed to be due at this time. Should any fee be required, however, please

---

attempted to respond to the Examiner's rejections by presenting arguments against both § 102 and § 103 rejections.

charge such fee to Bingham McCutchen LLP Deposit Account No. 50-4047, Order No.  
20002.0350.

Respectfully submitted,  
BINGHAM McCUTCHEN LLP

Dated: October 2, 2007

By: Stephanie D. Scruggs

Stephanie D. Scruggs, Registration No. 54,432

BINGHAM McCUTCHEN LLP

2020 K Street, NW

Washington, D.C. 20006

(202) 373-6755 Telephone

(202) 373-6001 Facsimile